

Remarks

Claims 1-55 were originally filed in this application. Claims 1-40 were withdrawn from prosecution in response to a restriction requirement. Thus, claims 41-55 are currently pending in this application.

In this office action, the Examiner objects to claims 42, 43 and 52-55 due to minor informalities. The Examiner further rejects claims 41, 44 and 48-51 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,305,809 issued to Zadro (hereinafter "Zadro") in view of U.S. Patent No. 6,172,613, issued to DeLine et al. (hereinafter "DeLine"). The Examiner also rejects claims 42, 43, 52 and 55 under 35 U.S.C. §103(a) as being unpatentable over Zadro, in view of DeLine and further in view of U.S. Patent No. 3,377,474, issued to Corinaldi (hereinafter "Corinaldi").

By way of this response, Applicant amends claims 42, 43, 52 and 55. No additional claim fees are required by way of these amendments. Applicants believe that the application, as amended, is in condition for allowance. Reconsideration and reexamination of the application as amended is respectfully requested.

A. Objections to the Claims

The Examiner objects to claims 42, 43 and 52-55 due to minor informalities in the claims. By way of this Response, Applicant amends claims 42, 43, 52 and 55 to correct the referenced informalities. These amendments also correct the objections to claims 53 and 54. Reconsideration of the claims as presented is respectfully requested.

B. Rejections Under 35 U.S.C. §103(a)

Claims 41, 44 and 48-51 under 35 U.S.C. § 103(a) as being unpatentable over Zadro in view of DeLine. Claims 42, 43, 52 and 55 under 35 U.S.C. §103(a) as being unpatentable over Zadro, in view of DeLine and further in view of Corinaldi.

The Examiner's proposed combination of references do not teach nor suggest all of the claim limitations as set forth in the claims. MPEP §2143.01 details the basic requirements necessary to establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either if the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is clear from a reading of both the references that neither contains a suggestion or motivation to combine the references in the manner suggested by the Examiner. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." See MPEP §2143.01 citing all cite *Al-Site Corp. v. VSI Int'l Inc.*, 174 F3rd 1308, 50 USPQ 2d 1161(Fed Cir. 1999).

One of ordinary skill in the art would not combine the Zadro and DeLine references to create Applicant's claimed invention. In fact, it is a significant leap to consider mirrors in such divergent technology areas as being analogous art. The Examiner cannot establish how Zadro and DeLine are analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Zadro is directed to a wall-mounted cosmetic mirror having two distinct mirror assemblies removably connected to a base. Each mirror assembly includes a mirrored surface mounted on a flexible arm designed to provide a single magnification level. In order to change the magnification level of the mirror, a separate mirror assembly must be mounted on the base. Furthermore, Zadro fails to teach or disclose Applicant's inventive concept of providing one or more information displays in the mirrored surface.

DeLine discloses a completely different mirror arrangement than that contemplated by either Zadro or Applicant. DeLine discloses a rearview mirror assembly for a vehicle which incorporates a display arrangement that provides vehicle information through a window in the mirrored surface. A vehicle rearview mirror is designed to accomplish a number of objectives not otherwise considered or disclosed by Applicant's disclosure.

The Examiner has used impermissible hindsight to combine the teachings of Zadro and DeLine to attempt to piece together the Applicants' invention. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. (See, MPEP § 2143; see also, *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Combining prior art references without evidence of ... suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.")).

Furthermore, even if the cited references, alone or in combination, resulted in the presently pending invention, the Examiner has failed to provide the proper motivation to combine the teaching of Zadro and DeLine as is required for a *prima facie* case of obviousness under 35 U.S.C. § 103(a). In particular, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention". (See, MPEP § 2141.03, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). "The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is

evidence of nonobviousness". (See, MPEP § 2145, X., 3., citing *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986)).

It is highly unlikely, if not improbable, that one of ordinary skill in the art would take the two distinct mirror assembly concept of Zadro and combine the features of a vehicle rearview mirror of DeLine to create Applicant's single housing, dual mirror invention. Therefore, there was no motivation to combine the cited references as suggested by the Examiner, and the rejection should be withdrawn.


Claims 42, 43, 52 and 55 under 35 U.S.C. §103(a) as being unpatentable over Zadro, in view of DeLine and further in view of Corinaldi. Claims 42-55 all depend from allowable subject matter presented in independent claim 41. In light of the amendments made in this Response, in addition to the arguments presented above, Applicant respectfully suggests that claims 41-5, as amended and originally presented, are in condition for allowance. Reconsideration of the claims as presented is respectfully requested.

C. **Conclusion**

Applicants have made a genuine effort to respond to each of the Examiner's objections and rejections in an effort to advance the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is requested to telephone the undersigned at his convenience.

A check in the amount of \$450.00 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,
Mordechai Lev

By 
Matthew R. Mowers
Reg. No. 44,956
Attorney/Agent for Applicant

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BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351